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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Everex Systems, Inc.

Serial No. 75/478,598

Joseph L. Strabala for Everex Systems, Inc.

Rodney Dickinson, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hairston, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Everex Systems, Inc., seeks registration of the mark "FREESTYLE" for goods identified in the application as "computers, namely portable and hand held computers," in International Class 9.[1]

The Trademark Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), citing a registration for the mark "FREESTYLE" as shown below, for goods identified as "computer software for recognition of

[1] Serial No. 75/478,598, filed May 4, 1998. The application is based upon use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), with January 1998 alleged as the date of first use of the mark anywhere and January 1998 alleged as the date of first use of the mark in commerce.

handwritten characters and images of characters," in International Class 9,[2] as a bar to registration of applicant's mark.

FreeStyle

The refusal to register was made final on the ground that applicant's mark, when applied to its goods, so resembles the registered mark as to be likely to cause confusion, to cause mistake, or to deceive.

In the course of rendering this decision, we have followed the guidance of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors which, if relevant, must be considered in determining likelihood of confusion.

As to the marks, the Trademark Examining Attorney finds them to be substantially identical, and applicant does not dispute this conclusion.

Turning to the goods, the Trademark Examining Attorney contends that based upon evidence extracted from the LEXIS/NEXIS® database, "… handwriting recognition software [registrant's goods] is repeatedly referred to as an important

[2] Reg. No. 2,084,691 issued on July 29, 1997 to ParaGraph International, maturing from intent-to-use application Ser. No. 74/733,939, filed on September 25, 1995. The registration sets forth dates of first use in 1995.

feature of hand held computers [applicant's goods herein]." This conclusion is consistent with applicant's own specimens of record, flows from registrant's specimens (as submitted by applicant herein), and indeed, with good reason, is not vigorously contested by applicant.

However, applicant has argued throughout the prosecution of this application, that based upon its ownership of an incontestible registration of the mark "FREESTYLE" for "computer programs and instruction manuals sold as a unit for graphic arts and paint," also in International Class 9,[3] that the real issues herein should be stated as follows:

1. Who is the prior registrant in International Class 9 under the undisputed facts with respect to a Section 2(d) analysis -- Applicant, owner of Registration No. 1,643,424 (sic) for FREESTYLE, or owner of Registration 2,084,469 for FREESTYLE?

2. Is it proper to reject the application of the owner of the prior, incontestible, registration for the mark FREESTYLE on a junior registration for the same mark in the same International Class (here class 9), when owner of the earliest registration (senior registrant) expands the use of FREESTYLE from computer software to computers where the junior registraion covers only software?

Applicant argues that it is perverse to refuse registration herein when applicant already owns a registration

[3] Registration No. 1,631,424, issued on January 15, 1991, based upon application Ser. No. 74/032,749, filed on February 24, 1990, claiming dates of first use of March 16, 1988.

for the identical mark for similar goods – namely, for computer programs and instruction manuals sold as a unit for graphic arts and paint. While we are not unsympathetic to the notion of basic equity raised by applicant herein, priority is not an issue in the context of an *ex parte* appeal. Having chosen to co-exist with the use and registration of the cited "FreeStyle" mark on handwriting recognition software, applicant cannot now, in this *ex parte* case, bring a collateral attack upon the validity of the cited registration. Rather, the sole question facing this panel herein is whether there is a likelihood of confusion when the same mark is used for registrant's handwriting recognition software and for applicant's hand held computers. On the question of the relatedness of these goods, we are firmly convinced that these goods are closely related in that they are complementary, and that they move in the same channels of trade to ordinary purchasers.

Accordingly, having acknowledged that applicant has a right to exclude others from use of its mark on software for graphic arts and paint, we find that when applicant's pre-existing rights are balanced against the other *du Pont* factors herein, the scales remain tipped in favor of affirming the instant refusal. *See In re Sunmarks, Inc*. 32 USPQ2d 1470 (TAB 1994) [each application must be separately examined, even if

applicant owns prior registrations for the identical mark for goods closely related to those in the application].[4] As contrasted with the facts in ***Sunmarks***, where the Board found an overlap in goods between the application and applicant's earlier registration, here there is no overlap at all between the goods in the application and the earlier registration.

We find the reasoning of the Board in ***Sunmarks*** to be most applicable in the current case:

> This Office should not be barred from examining the registrability of a mark when an applicant seeks to register it for additional goods as it does here, even when the additional goods are closely related to those listed in a prior registration. As the Board stated in ***In re BankAmerica Corp***., 231 USPQ 873, 876 (TTAB 1986):
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> > The cases are legion holding that each application for registration of a mark for particular goods or services must be separately evaluated. *See, for example*, ***In re Loew's Theatres, Inc***., 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) [other citations omitted]. Section 20 of the Trademark Act, 15 USC Section 1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not be delegated by adoption of conclusions reached by Examining Attorneys on different records.

[4] *See also* Prof. J. Thomas McCarthy, 3 McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §23.78, pp. 23-165 - 23-166, fn.7 (which also cites to ***Sunmarks***, 4th ed., 1998.

> Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by an Examining Attorney cannot control the result of another case.

We conclude that consumers familiar with registrant's computer software for recognition of handwritten characters and images of characters sold under its “FreeStyle” mark would be likely to believe, upon encountering applicant's mark “FREESTYLE” for computers, namely portable and hand held computers, that the goods originated with or were associated with or sponsored by the same entity.

Decision: The refusal under Section 2(d) is affirmed.

P. T. Hairston

D. E. Bucher

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board